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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/646,347	01/04/2001	Marilyn E. Karaman	FB RICE & Co.	8741

7590 06/04/2003
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EXAMINER

CINTINS, IVARS C

ART UNIT	PAPER NUMBER
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1724

19

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/646,347

Applicant(s)
Karaman et al.

Examiner
Ivars Cintins

Art Unit
1724



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 13, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 27 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 14 6) ☐ Other:

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The numbering of claims is not in accordance with 37 CFR § 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). Accordingly, newly presented claim "14" has been renumbered as claim "27."

Also, it is noted that Applicant has failed to identify, in APPENDIX A, the following changes made to the claims:

- (1) changing "protozoa" to "biological species" in the first line of claims 1 and 6;
- (2) adding "Escheria Coli" to claim 6; and
- (3) changing the dependency of claim 8 from "claim 2" to "claim 1 or 2."

Applicant is cautioned that all future amendments must indicate all of the changes made.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 1-10 and 27 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The limitation that the aluminum based medium is "uncoated" (claim 1, line 2; claim 27, line 3) does not appear to be supported by the disclosure originally filed, and hence constitutes **new matter**.

Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the removal of microbiological contaminants from water (see page 1, line 7 of the specification), does not reasonably provide enablement for the removal of other "biological species" (e.g. fish, humans, etc.) from such water. Accordingly, the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 4, 5 and 8/1-10/1 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The term "preferably" (claim 4, line 2) is vague and indefinite as to the surface density of the Al-OH groups. Claim 5 depends from claim 4, and is therefore also indefinite. Claim 8/1 is indefinite because the term "the alumina" lacks antecedent basis when this claim depends from claim 1, since claim 1 recites "an aluminum based medium" and is not limited to alumina. Claims 9/8/1 and 10/9/8/1 depend from claim 8/1 and therefore suffer similarly.

Applicant's arguments filed January 13, 2003 have been noted and carefully considered but are not deemed to be persuasive of patentability. Applicant argues that the limitation of an uncoated medium is supported by page 8, line 25 to page 9, line 10 of the specification. It is pointed out, however, that while this portion of the specification does not disclose a "coated" medium, it also does not teach that the medium is "uncoated." Accordingly, the recitation of an uncoated aluminum based medium in claims 1-10 and 27 is not deemed to be supported by the disclosure originally filed, and hence constitutes **new matter**.


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Claims 1-10 and 27 have not been rejected over "art" because it is agreed that the references of record do not teach or fairly suggest removing a biological species from water with an uncoated aluminum based medium of the type recited. Applicant is cautioned, however, that an attempt to overcome the above noted new matter rejection by deleting the newly added limitation (i.e. that the medium is "uncoated") may result in reinstatement of the art rejections based upon Mehkeri et al., as applied in the previous Office action

Any inquiry concerning this communication or earlier communications from the examiner should be directed to I. Cintins whose telephone number is (703) 308-3840. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Blaine Copenheaver, can be reached at (703) 308-1261.

The fax phone numbers for this art unit are: (703) 872-9311 for "Official" faxes after Final Rejection; (703) 872-9310 for all other "Official" faxes; and (703) 872-9492 for "Draft" and other "Unofficial" faxes.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.


Ivars C. Cintins
Primary Examiner
Art Unit 1724

I. Cintins
May 30, 2003